

## REMARKS

Claims 1, 6, 7, and 9 are amended.

These amendments are supported by the application as filed and no new matter has been added by any of the amendments.

Claims 1-19 are now present in this application.

Reconsideration of this application, in view of these amendments and remarks, is respectfully requested.

## Discussion

### I. Objection under 35 U.S.C. § 112, First Paragraph

The specification is objected to under 35 U.S.C. § 112, First Paragraph, as failing to comply with the written description requirement. The applicant respectfully traverses this rejection for the reasons given below.

To begin with, the applicant must object to this objection on the ground that the Office is conducting piecemeal examination of the sort that is forbidden by M.P.E.P. § 707.07(g):

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. (See MPEP § 904.03.) Major technical rejections on grounds such as lack of proper disclosure, lack of enablement, serious indefiniteness and *res judicata* should be applied where appropriate even though there may be a seemingly sufficient rejection on the basis of prior art. Where a major technical rejection is proper, it should be stated with a full development of

reasons rather than by a mere conclusion coupled with some stereotyped expression.

Since at least the 1960's the Office has employed the policy of "compact examination," in which the examiner is to conduct a through examination at the beginning and provide all objections and rejections at that time so the applicant may then address them, in order to expedite examination. In this application, claims 18 and 19 were added as new claims in the "Amendment and Response" mailed on August 9, 2005 and received by the Office on August 12, 2005. This was followed by the non-final office action of October 28, 2005 (mailed on October 31, 2005) and the final office action of June 26, 2006 (mailed on July 5, 2006). Neither of these office actions contained a written description objection or the accompanying rejection of claims 18 and 19 on that ground, even though the same examiner who issued the final office action of June 26, 2006 also issued the currently outstanding office action. The Examiner is respectfully asked to take this objection into account and provide an explanation in the next office action.

Proceeding to the substance of the objection, the applicant must state that although the objection is ostensibly one for lack of compliance with the written description requirement, *i.e.*, communication of possession at the time of filing of the later claimed subject matter, the Examiner states "[t]he applicants [sic] have failed to provide an enabling disclosure in the detailed description of the embodiment." The Examiner is respectfully asked to clarify whether the objection is on the basis of lack of written description or lack of enablement, *i.e.*, teaching one of ordinary skill how to make and use the claimed invention.

Finally, the applicant notes that in the "Amendment and Response" mailed on August 9, 2005 he identified support for the new claims at "in particular paragraphs

[0028] and [0039] of the specification.” It is respectfully suggested that a review of the “Profile.xml file” provided in paragraph [0028] will be instructive, because the “weightings” are specifically shown in that example. The Examiner is respectfully asked to comment on the disclosures in these paragraphs should he not withdraw the objection.

For at least the foregoing reasons, the objection to the specification for lack of written description should be withdrawn.

## **II. Rejections under 35 U.S.C. § 112, First Paragraph**

Claims 18 and 19 were rejected under 35 U.S.C. § 112, First Paragraph, as failing to comply with the written description requirement. The applicant respectfully traverses this rejection for the reasons given above in response to the objection to the specification.

It is respectfully submitted that the rejection of claims 18 and 19 under 35 U.S.C. § 112, Second Paragraph should be withdrawn.

## **III. Rejections under 35 U.S.C. § 112, Second Paragraph**

Claims 1-19 were rejected under 35 U.S.C. § 112, Second Paragraph, as being indefinite. The applicant respectfully traverses this rejection for the reasons given below.

The Examiner is respectfully reminded of the Office’s policy concerning piecemeal examination. The language of claims 1 and 7 that attracted the current indefiniteness rejection was in the claims as filed on January 18, 2001 and passed muster

in five office actions (non-final office action of March 5, 2004, non-final office action of November 29, 2004, final office action of March 4, 2005, non-final office action of October 28, 2005, and final office action of June 26, 2006 (this one issued by the current Examiner)(the dates of the office action that are given are the dates of filing and not the dates of mailing).

Nevertheless, claims 1 and 7 are amended to address the alleged indefiniteness identified by the Examiner. Claim 9, although not specifically mentioned by the Examiner, is believed to present the same issues as identified by the Examiner and is amended to conform to the amendments of claim 1.

Claims 2-6, 8, and 10-18 depend from one of claims 1 or 9 and are believed to have been rejected solely on the basis of that dependency.

Claims 1, 6, and 9 are also amended for consistency to refer to "profile file" instead of only "profile."

The rejection of claims 1-19 for lack of definiteness should be withdrawn.

#### **IV. Rejections under 35 U.S.C. § 103(a)**

##### **A. Claims 1-3 and 5-13**

Claims 1-3 and 5-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,230,199 B1 to Revashetti, et al. ("Revashetti") in view of U.S. patent 5,860,071 to Ball ("Ball"). The Applicant respectfully traverses this rejection for the reasons given below.

Claims 1 and 9 are the independent claims present in this application and both are rejected over Revashetti in view of Ball.

Claim 1, as amended, recites:

Process for personalized access to information available on the Internet network, comprising:

creating in the user's computer at least one profile file comprising private data owned by the user and data regarding the technical specifications of the user's computer;

repeatedly polling from the user's computer a service provider in order to receive an offer file containing matching rules for matching services accessible via the Internet to said at least one profile file;

applying in the user's computer the matching rules in the offer file to the profile file in order to select one or more services from the offer file, wherein no information from the at least one profile file is exported from the user's computer;

generating in the user's computer the code of a HTML page describing only said selected services; and

pushing said HTML page code into a web browser in the user's computer for permitting direct access to the services selected.

Revashetti does not teach or suggest "creating in the user's computer at least one profile file comprising at least one of the data selected from the group consisting of private data owned by the user and data regarding the technical specifications of the user's computer." Revashetti teaches completion of a user profile at step 306, while the user of the client computer is connected to a web site located on the service provider computer system. Revashetti at column 7, line 58 to column 8, line 12. The "user profile or relevant elements thereof are optionally downloaded to the client computer for use by the opportunity detection object, preferably by the opportunity analysis method." Id. at

col. 8, lines 12-15. The user profile is therefore created on the service provider computer system, not the user's computer.

Revashetti also does not teach "applying in the user's computer the matching rules in the offer file to the profile file in order to select one or more services from the offer file, wherein no information from the at least one profile file is exported from the user's computer." In Revashetti, the information for the user profile is exported from the client's computer to the service provider computer system for creation of the user profile, as discussed above. As noted in the specification of the instant application, an object accomplished by the disclosed process is to carry out customer targeting *without exporting any information from the user's computer*, page 11, lines 10-12, and in particular the user's private data, page 12, lines 25-26.

Revashetti therefore does not teach or suggest all of the features of claim 1. Ball was cited *only for teaching the process of repeatedly polling a service provider* and otherwise does teach or suggest the process of claim 1. The applicant respectfully submits that a *prima facie* case of obviousness has not been made out at least because the cited art does not teach or suggest all the claim limitations. See M.P.E.P. § 2142. The rejection of claim 1 should be withdrawn.

Claim 9, as amended, recites:

Apparatus for personalizing the access to information available on the Internet network, comprising:

means provided in the user's computer for creating at least one profile file comprising private data owned by the user and data regarding the technical specifications of the user's computer;

means provided in the user's computer for polling at predetermined instants a service provider in order to receive a file

containing information associated with matching rules to be confronted with said at least one profile file;

means provided in the user's computer for matching the data received in accordance with said matching rules in order to select some pieces of information, wherein no information from the at least one profile file is exported from the user's computer;

means for generating in the user's computer the code of a HTML page containing only said selected pieces of information; and

means for pushing said HTML page code into a web browser in the user's computer for permitting direct access to the information being selected.

Claim 9 recites an apparatus but has components corresponding to the steps of the process of claim 1. The rejection of claim 9 over Revashetti in view of Ball should be withdrawn for the same reasons as for claim 1,

Claims 2, 3, and 5-8 depend from claim 1 and claims 10-13 depend from claim 9. These claims are allowable over Revashetti in view of Ball for at least that reason and the additional features recited in those claims. The rejection of claims 2, 3, 5-8, and 10-13 should be withdrawn.

For the reasons given, claims 1-3 and 5-13 are not unpatentable and the 35 U.S.C. § 103(a) rejection of claims 1-3 and 5-13 should be withdrawn.

#### **B. Claim 4**

Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Revashetti in view of Ball, and further in view of U.S. patent 5,710,884 to Dedrick

("Dedrick"). The Applicant respectfully traverses this rejection for the reasons given below.

Claim 4 depends from claim 1 and adds the feature "wherein said profile file is encrypted into said local user machine." Dedrick is cited only for teaching encryption of personal profiles on a computer.

As noted above, a *prima facie* case of obviousness of the subject matter of claim 1 over Revashetti and Ball has not been established. For at least this reason, claim 4 is not unpatentable and the 35 U.S.C. § 103(a) rejection of claim 4 should be withdrawn.

### **C. Claims 14-17**

Claims 14-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Revashetti in view of Ball, and further in view of U.S. patent 6,487,566 to Sundaresan ("Sundaresen"). The Applicant respectfully traverses this rejection for the reasons given below.

Claims 14-17 depend directly or indirectly from claims 1 and 9. Sundaresen is cited for teaching the use of XML files in connection with the features added by these claims.

As noted above, a *prima facie* case of obviousness of the subject matter of claims 1 and 9 over Revashetti and Ball has not been established. For at least this reason, claims 14-17 are not unpatentable and the 35 U.S.C. § 103(a) rejection of claims 14-17 should be withdrawn.



**D. Claims 18 and 19**

Claims 18 and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Revashetti in view of Ball, and further in view of U.S. patent 6,317,722 to Jacobi ("Jacobi").

Claims 18 and 19 depend directly from claims 1 and 9, respectively. Jacobi is cited for disclosing the process of assigning user-defined weightings to the data in the profile file to indicate specified fields that are regarded as being of particular importance and taking these weightings into account when applying the matching rules in the offer file to the profile file in order to select one or more services from the offer file.

As noted above, a *prima facie* case of obviousness of the subject matter of claims 1 and 9 over Revashetti and Ball has not been established. For at least this reason, claims 18 and 19 are not unpatentable and the 35 U.S.C. § 103(a) rejection of claims 18 and 19 should be withdrawn.

**Conclusion**


In view of the above, the Applicant submits that the application is now in condition for allowance and respectfully urges the Examiner to pass this case to issue. The Examiner is respectfully invited to telephone the undersigned attorney as needed in order to advance the examination of this application.

\* \* \*

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting

an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 9, 2007.

  
\_\_\_\_\_  
Lucy C. Derby

July 9, 2007  
(Date)

encls.: petition for extension of time w/ fee  
return receipt postcard

Respectfully submitted,

  
R. Dabney Eastham  
Attorney for Applicants  
Reg. No. 31,247  
LADAS & PARRY  
5670 Wilshire Boulevard, Suite 2100  
Los Angeles, California 90036  
(323) 934-2300  
(323) 934-0202 facsimile  
reastham@ladas.com